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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/030,702	02/25/98	MACNEIL	R 8527-002

Q32/0119  
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EXAMINER

CHAMBERS, M

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

01/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/030,702

Applicant(s)  
Macnell

Examiner  
M. Chambers

Group Art Unit  
3711



☒ Responsive to communication(s) filed on Sep 21, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

This Office Action is a response to the Application filed on:

Number	Name	Date	Claims	Independent Claims
09030702	Macneil	2/25/98	16	3

**DETAILED ACTION**

***Oath/Declaration***

1. The reissue application declaration is defective in that it fails to specifically point what the error is that the reissue seeks to correct. Applicant should note what the defect in the original patent was and how it affects the viability of the patent, why the original application failed to include the claim in the original patent and where support for the claim is found in the specification. Also, the declaration reads as "broadening" i.e. "Patent failed to claim a stick head offset as shown and described" but is in reality narrowing. Unless there is a statement that the claims are too broad, there is no basis for reissue as presently set forth.

Claims 1-16 are rejected as being based upon a defective reissue declaration under 35 USC 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Note: In the follow up action, it is requested that the applicant provide a legible copy of the signed statement under 37 CFR 3.73(b). The faxed copy is somewhat illegible and a legible copy is required for the record.

It is unclear to the examiner if the applicant wishes to narrow or broaden the patent for the following reasons. (The assignee should note that the patent office cannot broaden the patent at the request of the assignee. If a broadening of the patent is desired, the consent of the inventor is needed.)

**Narrowing of Claims:**

- 1) The original specification does not disclose any information about the off-set mouth.
- 2) Two of the three independent claims have been modified to include this feature (Claims 1,12).

As claim 5 does not include this modification, the modified set of claims would narrow the metes and bounds of the patent to include both off-set and non-offset mouths.

**Broadening of Claims:**

- 3) The removal of language about the first sidewall in claim 12 would broaden the claims of the issued patent by removing this limitation. This problem was noted in the previous office action but was not addressed in the response to that action. The request for an explanation is again repeated.
- 4) The declaration by the applicant that this feature was not sought in the original application because it is in the prior art of Canada would indicate the applicant did not intend to claim this feature as originally envisioned. If the applicant has obtained any additional information or has knowledge about the allegations claimed by the inventor that the feature is common knowledge in Canada, they are requested to furnish copies of this information with the next response to the office action.

***Specification***

The applicant has not supplied a copy of the original patent clearly showing what information is to be removed from the patent and what information is to be added. Information to be removed should be bracketed [] and information to be added to be underlined and noted with -- marks before and after the added phrase or sentence.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6-8,10,11,16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. There is insufficient antecedent basis for these limitations in the claims.

Claims 6,7,8 are unclear as they further limit an inner wall segment which is not disclosed in the independent claim 5.

Claim 10 recites the limitation "said shank portion" in line 2 and "said longitudinal thongs" in line 4.

Claim 11 recites the limitation "said shank end portion" in line 3.

Claim 16 is unclear as it refers to claim 17 which is non-existent.

### *Reissue Applications*

3. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,494,297, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

As far as understood

4. Claim 12 as far as understood is rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee.

Claims 13-16 are rejected as they are dependent on claim 12.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Chambers** whose telephone number is (703) 306-5516. The examiner can normally be reached on Mon.-Fri. from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette E. Chapman, can be reached on (703) 308-1310. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1078.

***Faxing of Responses to Office Actions***

In order to reduce pendency and avoid potential delays, TC3700 is encouraging FAXing of responses to Office Actions directly into the group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner, art unit and case number at the top of your cover sheet. Papers submitted via FAX into TC3700 will be promptly forwarded to the examiner.

  
JEANETTE CHAPMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700